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REMARKS**Examiner Interview**

Applicant thanks Examiners Bates for participating in the Examiner Interview on April 21, 2006 in which the relevance of the Owens et al. reference was discussed. According to the Office, Owens et al. is now offered to show "mobility" and not for the proposition of "timeshifting."

Previous Outstanding Rejections

The previous response which included the declaration of Brian J. Gibbons, a disinterested third party that applicant has known for over ten years, was sufficient to overcome all prior outstanding rejections to the claims.

The only remaining rejections, which were first presented in the current Office Action, are under 35 U.S.C. § 103 and are addressed herein below. Claims 61, 74, 75, 76 and 77 have been amended to more clearly point out applicant's invention.

Claim Rejections Under 35 U.S.C. § 103 Should Be Withdrawn

Claims 41-43, 45, 47, 48, 50-53, 55-56, 58, 61-64, 74-77 and 81 stand rejected under 35 U.S.C. § 103 as unpatentable over Robbins, U.S. Patent No. 6,317,882, in view of Titlebaum et al., U.S. Patent No. 6,549,774, in further view of Owens et al., U.S. Patent No. 6,067,278 for the reasons set forth on pages 3 through 16 of the Non-Final Office Action.

Claims 46 and 57 stand rejected under 35 U.S.C. § 103 as unpatentable over Robbins in view of Brown. and Owens et al., in further view of Barton, U.S. Patent No. 6,233,389. Claims 49, 59, 79, and 80 stand rejected under 35 U.S.C. § 103 as unpatentable over Robbins in view of Brown and Owens et al., in further view in further view of Wall, U.S. Patent No. 6,055,244.

Applicant respectfully submits that the Office's continued inclusion of the previously overcome Brown reference is merely a carry-over from the earlier rejection and is in error. Fortunately, because the base claims from which claims 46, 49, 57 59, 79 and 80 depend are allowable for all the reasons set forth below, these claims are also

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allowable and the improper bases for the rejections recited in the Office Action are moot.

For the following reasons, applicant respectfully submits that the claims are patentable in view of the art of record. First, the combination of references fails to at least suggest, much less disclose, each and every claim limitation of the independent claims and the claimed invention provides novel and nonobvious solutions to technological problems, including how to find works of authorship playing on channels or stations in a mobile satellite audio radio context by including information that can be used to identify user desired content.

Second, and assuming solely for the sake of argument that the combination of references does disclose each limitation, the Office has failed to establish a *prima facie* case for obviousness because there is no motivation, suggestion or teaching, other than from applicant's disclosure, to modify or combine the reference teachings and because the present invention provides synergistic, new and unexpected results including (1) enhanced accuracy and (2) greater territorial coverage with (2a) reduced signal dropouts and (2b) reduced interference.

1. The Combination of References Does Not Disclose, Teach, or Suggest All of the Claim Limitations

The present invention is directed to methods and devices that solve, at least, the problem of finding user desired content playing on satellite radio broadcasts. In so doing, the present invention, at least, synergistically provides the unexpected results of (1) increased accuracy and number of hits, and (2) reduced and/or eliminated interference over an increased territory, all on a single receiver.

For a finding of obviousness, it is well established that the prior art reference (or references when combined) must teach or suggest all the claim limitations, see, e.g., MPEP § 2142. Here the claims recite features that are absent from the references, as described further below.

1A. Claims 43 and 52 Are Patentably Distinct From the Proposed Combination of Robbins, Owens et al., and Titlebaum et al.

Claims 43 and 52 are patentable because they each recite limitations that are neither disclosed nor suggested by any of the cited art.

As the Office is aware, [A]ll words in a claim must be considered in

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judging the patentability of that claim against the prior art.” *In re Wilson*, 424 F.2d 1382, 1385 (CCPA 1970) (emphasis added). Here the Office continues to openly ignore explicit limitations in the claims and points to irrelevant sections of art in support of the rejections.

Specifically, claims 43 and 52 explicitly require a comparison at
“0.01 second to 3 minute intervals.”

The Office points to column 5, line 62 through column 6, line 10 of Robbins for support of the rejection (see, e.g., page 5, line 4 of the Office Action dated 3/30/06). However, the referenced section fails to support the rejection of claims 43 and 52. Specifically, the cited portion recites:

“By using a television system in accordance with one embodiment of the present invention, the viewer may activate an automatic reminder system that will detect and store an ID code that is broadcast with the commercial of the program that is broadcast, wherein the ID code corresponds to the program that is broadcast. After activating the automatic reminder system, when the broadcast program is eventually broadcast, an ID code transmitted with the broadcast is detected, the ID code of the broadcast is compared with the previously stored ID code, and the system may: compile the information into a database that the viewer can access; automatically tune to the channel that is broadcasting the program at the time of the broadcast; display a message on the television when the program time arrives; automatically initiate the recording of a recording device; or take any other action to alert or make it easy for a viewer to remember to watch the program.”

Contrary to the assertions made in the Office Action, the cited section merely relates to compiling information and initiation of recording in a television context. In addition to the fact that the claims are limited to “satellite audio radio” and not a television system, nothing in the reference, much less the cited section, in any way refers to “0.01 second to 3 minute intervals” as required by the claims. This claimed feature provides the advantage of repeatedly searching in a specific time frame sufficient to alert

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a user before a user designated work of authorship is finished playing on a channel or station.

Accordingly, because every feature of the claims is not disclosed or suggested in the reference or combination of references, applicant respectfully requests withdrawal of the rejection.

1B. Claim 77 Recites Undisclosed and Patentable Features

Dependent method claim 77 also recites:

“receiving information from a terrestrial repeater of the information from a satellite, wherein the information from the terrestrial repeater also indicates which works of authorship are being broadcast on one or more...”

Again, contrary to the assertion by the Office, Titlebaum et al. fails to teach or suggest the method limitation of “the information from the terrestrial repeater also indicates which works of authorship are being broadcast...”

At best, the section recited in Titlebaum et al. merely indicates that the terrestrial repeater signal provides a repeat of digital satellite audio radio, a.k.a. SDARS. Column 4, lines 60 to 65 of Titlebaum et al. recites:

“The microcontroller 44 can also indicate via the display 46 the signal strength (i.e., RSSI) of satellite or terrestrially repeated SDARS signals, and visual effects (e.g., a dynamic bar graph display corresponding to the output levels of the audio program from the auxiliary audio source), among other displayable information.”

This disclosure of the mere existence of terrestrially repeated SDARS or “Satellite Digital Audio Radio Signals” is far less than the disclosure of SDARS and additional information, as required by the claims. The reference also fails to disclose using information from the terrestrial repeater to determine what is being played on one or more channels such that a user can be alerted when a desired work is broadcast.

The invention of dependent claim 77 further synergistically reduces interference and enhances accuracy, both to an even greater extent than

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the other claimed inventions, as previously described on page 9, above.

Accordingly, for all the reasons set forth above, applicant respectfully requests withdrawal of the rejections.

1C. The Previously Presented and Currently Amended Claimed Inventions Are Patentably Distinct From the Proposed Combination of Robbins, Owens et al., and Titlebaum et al.

As with claims 43, 52, and 77, the rejections to all of the previously presented and currently amended independent claims ignores explicit limitations and the Office has not given due weight to (1) these explicit claim limitations (e.g., the limitations set forth above), as well as (2) how the invention is claimed as a whole, as described further in Part 2, below. Instead the Office has chosen to focus solely on the limited teachings of Titlebaum et al. and asserted that by merely including the teachings of Titlebaum et al. (and Owens et al.) in Robbins in a piecemeal fashion, one arrives at the claimed invention.

With respect to all of the current claims, Robbins is deficient in its teachings in that, at least, (1) it fails to disclose or suggest in a mobile context receiving on a single receiver a digital satellite signal. It is further deficient in that it does not disclose (2a) receiving a satellite audio radio signal from a digital audio radio satellite on a single satellite audio radio receiver, where the signal further includes information that corresponds or relates to works of authorship playing on one or more satellite audio radio channels, as claimed in independent claims 41, 43, 61, 75 and 76. Robbins is further deficient in that (2b) it also fails to disclose or suggest devices/apparatuses configured to receive satellite audio radio and information, as claimed in independent claims 74 and 52.

Moreover, (3) Robbins fails to teach or suggest including additional information with the satellite audio radio signal which can be used to compare what is playing on one or more channels with a user designated work of authorship, much less doing so in a mobile context.

In an attempt to cure these deficiencies of Robbins, the Office asserts that it would have been obvious to one of ordinary skill in the art to use Titlebaum et al.'s teaching and combine it with Robbins' disclosure in order to expand Robbins "in order to allow Robbins the increased functionality of working with even more types of radio and

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video communications.” (see, e.g., the first full paragraph on page 4 of the Office Action). The Office cites Owens et al. for the limited proposition of showing “mobility.”

Of most relevance here is the fact that the combination of Robbins, Titlebaum et al. and Owens et al. does not disclose, much less suggest or teach, a satellite digital audio radio signal and additional information which relates or corresponds to a work of authorship which can be provided on one or more digital satellite audio radio channels or stations, much less using that information in a manner consistent with the present invention.

The primary section of Titlebaum et al. that the Office relies upon in support of the rejection is column 4, lines 49 through 59, which recites:

“As shown in FIG. 2, the receiver unit 14 is provided with a microcontroller 44, a display 46 and a user input device 48 such as a number of buttons and dials. The user input device 48 can comprise satellite broadcast channel selection buttons, as well as volume control and tuning buttons or dials. The microcontroller 44 can receive data from a satellite receiver 50 connected to the antenna 18 or 26. The data is received via an input line 52 and provides information relating to SDARS, which can include, for example, satellite broadcast channel number, artist name, audio program title and data channel information.”

The preceding paragraph merely indicates that the data from receiver 50 to microcontroller 44 can include, for example, satellite broadcast channel number, artist name, audio program title and data channel information. This information is transmitted to the microcontroller via input line 52.

In addition to the fact that neither Titlebaum et al. nor Owens et al. are in the same field of endeavor as the claimed invention and neither are reasonably pertinent to the particular problem with which the inventor is involved, and thusly neither reference constitutes relevant art, see, e.g., *In re Clay* 23 USPQ2d 1058 (1992). Further, both references are devoid of any disclosure, teaching or suggestion that indicates the signal transmitted by a digital satellite audio radio satellite includes additional information concerning works of authorship, or a device configured to receive such further

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information, much less employing such information to a users advantage.

At best, Titlebaum et al. merely indicates that the data in input line 52 from receiver 50 to microcontroller 44 provides some information relating to SDARS. However, Titlebaum et al. fails to characterize the origin of the information, much less show or suggest a satellite radio signal *and* additional information both being received from a satellite, as claimed. This is particularly important when one considers that Titlebaum et al. itself indicates that the receiver can include additional inputs, as explained in the cited paragraph above, and the inclusion of any such information sent via input line 52 is entirely optional.

Also, the Office has not shown any evidence that the claimed feature allegedly set forth in Titlebaum et al. is inherent in the teachings of the disclosure and for the reasons set forth above, applicant respectfully submits that the alleged feature is not inherent, given at least the fact that additional, non-satellite radio signal inputs exist on the receiver. Nor has the Office articulated in any way how a motivation to combine would be inherent or implicit in the references, as detailed further below.

The combination also fails to resolve the deficiencies of Robbins to thereby arrive at the claimed invention. Specifically, and with deference to the actual claim language set forth above, none of the cited references, much less a combination of Robbins, Titlebaum et al. and Owens et al., teach or suggest a single device or method for receiving additional information with the satellite audio radio signal and comparing that information with designation of a work of authorship to determine whether the work is playing on a channel by comparing the additional information with the designation and looking for a match.

Thus, with respect to the independent claims, Titlebaum et al. and Owens et al. fail to cure the deficiencies of Robbins. Further, because each and every limitation of each claim is not provided by the combination of references, one of skill in the art would have had no reasonable expectation of success of arriving at the claimed invention. Accordingly, for the preceding reasons, applicant respectfully requests withdrawal of the rejections and allowance of the claims.

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2. The Office Has Not Shown Any Suggestion, Teaching or Motivation That Would Lead a Person of Ordinary Skill In The Art to Combine the References in the Manner Claimed

Assuming solely for the sake of argument that even if combined Robbins, Titlebaum et al. and Owens et al. disclose or suggest each and every independent claim feature, applicant respectfully submits that the Office has merely combined references without evidence of such a suggestion, teaching, or motivation, and has used the inventors disclosure as a blueprint for piecing together the art.

Further, applicant respectfully submits that the Office has improperly distilled the cited art references as well as the current claims down to their "gist" or "thrust" and has disregarded the requirement of analyzing the subject matter "as a whole," and accordingly, the Office has acted contrary to the requirements set forth in 35 U.S.C. § 103 and the holdings of numerous cases. See, e.g., *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984).

As already noted above, MPEP § 1242 requires that the prior art reference (or references when combined) must teach or suggest all the claim limitations. This point has been addressed in Part 1. Also, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Further, there must be a reasonable expectation of success of arriving at the claimed invention.

In the present case, the Office has (1) not specified the skill level of one of ordinary skill in the art, and (2) does not provide any objective evidence from Robbins, Titlebaum et al. or Owens et al., much less the prior art as a whole or even generally available knowledge (other than what has been gleaned from applicant's own disclosure, as described in more detail below in Part 2C) to suggest the desirability, and thus the obviousness, of making the combination. Accordingly, for the following reasons, the rejections under § 103 should be withdrawn.

2A. The Claims Provide Indicia of Unobviousness

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Applicant respectfully submits that the claims provide indicia of unobviousness. Specifically, according to MPEP 2144.04(II)(B), the omission of an element and retention of its function is indicia of unobviousness. *In re Edge*, 359 F.2d 896, 149 USPQ 556 (CCPA 1966).

Here, applicant's claimed invention omits key features of Robbins, yet retains the function of the omitted element and also obtains, at least, the advantages described herein. Thusly, the claims are unobvious over the cited art.

Specifically, Robbins (and therefore the alleged hypothetical combination of Robbins, Titlebaum et al. and Owens et al.) requires two or more receivers, namely one main receiver and one or more auxiliary receivers; to accomplish what applicant has done with just one satellite audio radio receiver.

In particular, Robbins is directed to many different embodiments for reminding a user that a broadcast is on a datastream. However, and most importantly, in order to achieve the objects of Robbins set forth in these embodiments, and in accordance with the purpose of the invention described in the Robbins reference, Robbins directs and teaches one of skill in the art to use auxiliary receivers. Applicant respectfully points out that the disclosure of Robbins is replete with instructions for the use and development of auxiliary receivers and the requirement for the use of auxiliary receivers is apparent throughout the teaching of Robbins.

For example, col. 11, lines 10-31, and in particular lines 25-31, col. 11, lines 47-53, and col. 24, lines 19-34, describe how to achieve the foregoing embodiments and objectives of Robbins using auxiliary receivers. Furthermore, the description of Fig. 1 of Robbins indicates that auxiliary receivers are used (see, e.g., col. 31, lines 62-67 (one auxiliary receiver) and col. 33, lines 24-37 (a plurality of auxiliary receivers)). Further, the written description of Fig. 5(A) denotes that the figure includes auxiliary receivers, see col. 32, lines 1-22. Other indicia of the requirement of one or more auxiliary receivers are apparent throughout the teaching of Robbins, as described hereafter.

Applicant respectfully points to Figs. 10(A) and 10(B), and the description thereof at col. 42, lines 19-53 of Robbins, which also outlines the requirement of auxiliary receivers. Applicant also respectfully points out that all of the independent claims of Robbins also require auxiliary receivers.

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Furthermore, the last paragraph before the “Exemplary Embodiment,” sets forth these requirements by reciting the following at col. 40, lines 1-6:

“The following exemplary embodiment, includes a receiving system having a plurality of auxiliary receiver [sic], each for scanning a plurality of data streams in an interlaced fashion. One of skill in the art, after reading the present disclosure, would know how to implement the remaining embodiments as described above in light of the following embodiment.” (emphasis added)

Thus, the above described paragraph proves that all of the preceding embodiments described in Robbins require one or more auxiliary receivers, consistent with all of the cited paragraphs above and the description of the exemplary embodiment, as detailed hereafter.

Most glaringly, Robbins’ exemplary embodiment itself, the description of which starts at col. 40, line 9, and which particularly references Figs. 8(A) and 8(B), explicitly requires a main receiver (804) and one or more auxiliary receivers (806).

The exemplary embodiment also provides insight as to the interaction that is required between the one or more auxiliary receivers and the main receiver, and the functions of each in the system of Robbins. Specifically, and as described at col. 40, lines 25-41, the main receiver 804 stores an ID code and the auxiliary receiver then scans the spectrum of data streams for ID codes and sends the ID codes to comparator unit 808. Thus, Robbins requires communication between the main receiver and one or more auxiliary receivers.

Accordingly, because applicant’s claimed invention scans one or more satellite audio radio channels or stations for information and compares the information to user designated work of authorship, in the absence of an auxiliary receiver, under the rules set forth in the MPEP § 2144, the claimed invention is unobvious because, generally, Robbins’ feature of one or more auxiliary receivers that scan for ID codes is omitted, while applicant’s invention retains that features function.

Additionally, following the teaching of Robbins, one of skill in the art would not have been motivated to integrate the auxiliary and main receivers together, much less arrive at the claimed invention with any expectation of success. This is

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because Robbins perceives a need for, and indeed discloses a requirement of, at least one auxiliary receiver, and specifically states why as described above. Yet Robbins also indicates that a plurality of auxiliary receivers is preferable to one. At col. 33, lines 24-37, Robbins recites:

“Another exemplary embodiment of a device used for the scanning step (S114) as described in FIG. 1, of an embodiment of the present invention, may include a plurality of auxiliary receivers to scan the data stream spectrum. This may increase the price of the system over that of one auxiliary receiver, however, the response time in which the system may automatically tune to a specific data stream may be decreased over that of one auxiliary receiver, since the total amount of time T spent detecting all the data streams would be divided by the number of auxiliary receivers. Therefore, the number of auxiliary receivers will proportionately decrease the amount of time needed to detect and compare a particular data stream.” (emphasis added)

As noted in the preceding paragraph, the invention of Robbins recognizes the advantages of a plurality of auxiliary receivers to proportionately decrease the amount of time needed to detect and compare a particular data stream relative to the time required for one auxiliary receiver, i.e. more is better.

In fact, the language of Robbins that is set forth above strongly teaches away from decreasing the number of auxiliary receivers because (1) the use of a plurality of auxiliary receivers is explicitly stated as providing superior results relative to a single auxiliary receiver, and (2) Robbins requires at least one auxiliary receiver, and (3) Robbins does not disclose that the objectives of the invention can be met, even in an inferior manner, in the absence of one or more auxiliary receivers. Accordingly, Robbins evidences the fact that it is disadvantageous to reduce the number of auxiliary receivers. Therefore, the disclosure of Robbins factually discredits and discourages the solution claimed by applicant.

Moreover, even if combined in the manner suggested by the Office, one of skill in the art would still not arrive at the claimed invention because the alleged and

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hypothetical combination would require a main satellite audio radio receiver and one or more auxiliary satellite audio radio receivers each in communication with the main receiver, which is far different from applicants claimed invention, particularly when one properly considers the claimed invention as a whole. Thus, one of skill in the art would have no expectation of success at arriving at the claimed invention.

Here, the Office, within the framework of §103, impermissibly picks and chooses from Robbins only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art., see, e.g., *In re Wesslau* (1965). Specifically, the Office Action fails to take into consideration the overall teachings of Robbins by reducing the reference teachings to its “gist,” and by not taking into consideration what Robbins teaches and suggests to one of ordinary skill in the art about how to actually achieve the general embodiments described therein.

As in *In re Wright* (1989), the Office’s attempt to show a suggestion of the claimed invention requires taking statements concerning Robbins wholly out of context and giving them meanings they would not have had to one skilled in the art having no knowledge of applicant’s invention, or for that matter to anyone else who can read the specification with understanding.

Based on the above, it is clear that the inventor of the present invention showed insight that was contrary to the expectations of the art, which is itself indicia of unobviousness. See, e.g., MPEP 2145(X)(D) and *In re Hedges*, 783 F.2d 1038, 228 USPQ 685 (Fed. Cir. 1986). Accordingly, applicant respectfully requests withdrawal of the rejection.

2B. The Office Provides No Objective Evidence of Obviousness And Thus Has Not Established A Prima Facie Case

Although applicant submits that the claims recite features that are not “old” as described above in Part 1, even if the features were to be considered “old” the combination would still be patentable. This is because the Federal Circuit has created a mandatory presumption, even in the PTO, that combinations of “old” elements are patentable. The presumption is in favor of the applicant, and can be overcome by the PTO only with “evidence” and “specific findings” of motivation or suggestion to

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combine. The evidence must be detailed. See, e.g., *In re Lee* (Fed. Cir. 2002).

Further, a mere statement that modifications of the prior art to meet the claimed invention would have been " 'well within the ordinary skill of the art at the time the claimed invention was made' " because the references relied upon teach that all aspects of the claimed invention were individually known in the art is not sufficient to establish a prima facie case of obviousness without some **objective** reason to combine the teachings of the references. *Ex parte Levengood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993).

It is well established that "[t]o support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985), MPEP § 2142.

Just as in *In re Kotzab*, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1318 (Fed. Cir. 2000), here the Office made no finding "as to the specific understanding or principle within the knowledge of the skilled artisan" that would have provided the motivation to combine Robbins with Titlebaum et. al., much less combining Robbins with any reference having pertinence to satellite radio, particularly in light of Robbins' requirement of using auxiliary receivers, to arrive at the claimed invention, as described above in Part 2A.

Also, the Office has not set forth any factual showing of what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole, would have suggested to those of ordinary skill in the art.

The Office also contends that it "would have been obvious to one of ordinary skill in the art at the time the invention was made... to allow Robbin's [sic] the increased functionality of working with even more types of radio and video communications." However, and similar to the court's opinion in *In re Dembiczak*, 175 F.3d 994 (Fed. Cir. 1999), the analysis performed by the Office is only limited to a discussion of the ways that the prior art references can be combined to read on the

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claimed invention, yet the analysis fails to clearly and particularly demonstrate how the references actually teach or suggest the combination to yield the claimed invention or the modifications of the art that are necessary to arrive at the claimed invention. Again, this is particularly pertinent in view of the teachings of Robbins at col. 33, lines 24-37 (as quoted above), and elsewhere, that clearly teach away from the claimed invention and require one or more auxiliary receivers in communication with a main receiver.

Because one of skill in the art must first remove one or more auxiliary receivers from Robbins to allegedly arrive at the claimed invention, as described above, such modifications renders Robbins unsatisfactory for its intended purpose based on the teachings of Robbins that indicate one or more auxiliary receivers are required for scanning data streams. Thus, there is no suggestion or motivation to make the proposed modification to arrive at the claimed invention. See, e.g., *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984).

Accordingly, based on the teachings of the references, there is no such relevant evidence as a reasonable mind might accept as adequate to support the conclusion of obviousness of the claims. Also, there is no substantial evidence to extrapolate the teaching to modify Robbins in any manner to arrive at the claimed invention. Therefore the rejection under 35 U.S.C. § 103 is improper and applicant respectfully requests that the rejection be withdrawn with respect to independent claims 41, 43, 52, 61, 74, 75 and 76, as well as the claims dependent thereon.

2C. The Office's Own Statements Show That It Has Fallen Into the Hindsight Trap

As explained further below, to the extent any reason is given for the combination of reference, "increased functionality" is far from the required objective standard required and described above, and merely results from hindsight.

As the court noted in *In re Kahn*, 441 F.3d 977 (Fed. Cir. 2006) "[d]efining the problem in terms of its solution reveals improper hindsight in the selection of the prior art relevant to obviousness" (quoting *Monarch Knitting Mach. Corp. v. Sulzer Morat GmbH*, 139 F.3d 877, 881 (Fed. Cir. 1998).

Here, the Office's own statement, which reads:

"to allow Robbin's [sic] the increased functionality of working

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with even more types of radio and video communications” openly defines a problem in terms of a solution presented by applicant’s claimed invention. Clearly, under the doctrines set forth in *In re Kahn*, the Office has used improper hindsight as the basis of the current rejections, particularly in view of the fact that none of Robbins, Titlebaum et al. or Owens et al. are concerned with searching for works of authorship in a mobile satellite audio radio context, nor in expanding the teachings beyond scope of the references themselves, i.e., each reference is complete in itself.

Applicant respectfully submits that “our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references.” *Dembiczak*, 175 F.3d at 999. This is because “[c]ombining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor’s disclosure as a blueprint for piecing together the prior art to defeat patentability- the essence of hindsight.” *Id.*

Although the MPEP at § 2145 indicates that “[a]ny judgement on obviousness is in a sense necessarily a reconstruction based on hindsight reasoning,” here it is clear that the Office has once again engaged in *impermissible* hindsight. This is because in the absence of applicant’s disclosure, a person of ordinary skill in the art would have had no motivation to combine the prior art teachings, much less have had motivation to combine the prior art teachings in the particular manner claimed for all the reasons described hereinabove. Here, the motivation to combine does not come from any of the references, but rather from the Office alone.

The Office also indicated in the Examiner Interview that Owens et al. is merely offered to show “mobility,” and not timeshifting. This further illustrates that the Office has engaged in piecemeal reconstruction using hindsight because Owens et al. is devoid of any disclosure or reason to combine it with Titlebaum et al. and/or Robbins and the Office provides no cogent reason for its combination other than to provide a single feature that the Office believes is absent from the remaining references.

Accordingly, applicants respectfully request withdrawal of the rejection.

3. Summary

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In summary, Robbins, Titlebaum et al. and Owens et al. are all deficient in that none suggest, much less disclose, the claimed invention *as a whole* and that (i) even if the references were to be combined, one skilled in the art would still not arrive at the claimed invention, as described in Part 1 and because Robbins requires one or more auxiliary receivers as described in Part 2A, (ii) that the Office has failed to show any objective evidence supporting the combination and because Robbins teaches away from the claimed invention (iii) the combination of Robbins with Titlebaum et al. and Owens et al. does not disclose or suggest searching for user designated works of authorship in a satellite audio radio context, and (iv) Titlebaum et al. fails to provide a motivation for a combination with Robbins and vice versa.

Therefore the rejection under 35 U.S.C. § 103 is improper and applicant respectfully requests that the rejection be withdrawn with respect to independent claims 41, 43, 52, 61, 74, 75 and 76.

Lastly, because claim 42 depends upon allowable claim 41, claims 45, 46, 47, 48, 49, 50, and 51 depend upon allowable claim 43, claims 53, 55, 56, 57, 58, 59, and 60 depend upon allowable claim 52, claims 62, 63 and 64 depend upon allowable claim 61, and claims 77, 78, 79, 80, and 81 depend upon allowable claim 76, under the doctrine set forth in *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988), these dependent claims are also allowable by virtue of the claims dependency upon allowable base claims and thus the rejections in light of Barton, Wall and Marko et al. have also been overcome.

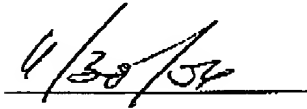
If the Office does not allow the claims, in any subsequent action, kindly specifically identify the motivation to provide the arrangement of each of the independent and dependent claims. If these issues are not addressed now, they will need to be addressed on appeal, which is not efficient for the Examiner or applicant.

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Conclusion

Applicant respectfully submits that all claim rejections have been overcome and that all pending claims are now in condition for allowance, early notice of which is earnestly solicited.

Respectfully Submitted,



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